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08/994,531 12/19/97 ARIAS

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EXAMINER

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ART UNIT

PAPER NUMBER

2711

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No. 08/994,531	Applicant(s) <b>SALVADOR et al.</b>
Examiner <b>Christopher Grant</b>	Group Art Unit <b>2711</b>

Responsive to communication(s) filed on 6/28/99 and 9/27/99

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

Claim(s) 1-15 and 32-47 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) 35-47 is/are allowed.

Claim(s) 1-15 and 32-34 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2711

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Kostreski et al. (Kostreski) (of record).

Considering claim 1, Kostreski discloses a system for communicating content to a plurality of subscribers. Note the following:

- a) the claimed plurality of receivers are met by home receivers (100) illustrated in figure 7;
- b) the claimed means for digitizing is met by digitizing means indicated in col. 9, lines 35-57;
- c) the claimed means for compressing is met by compressing means recited in col. 9, lines 35-37;
- d) the claimed multiplexer is met by multiplexer (12) (figure 6);
- e) the claimed modulating means is met by modulator (13);
- f) the claimed RF upconverter is met by upconverters (14) or (24) which upconverts in UHF spectrum, see col. 13, line 13 - col. 14, line 41;
- g) the claimed amplifier is met by amplifier (23);

Art Unit: 2711

- h) the claimed antenna is met by antenna (TXN); and
- i) the claimed aggregation of programming sources provided point to multipoint is met by the headend (10) providing plural video programs to multiple receivers (100).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kostreski and Hendricks (of record).

Considering claims 2-5, Kostreski discloses of coaxial cable, wireless microwave and other media can be used for transmitting information. However, he fails to specifically disclose signals from the content provider is transmitted via satellite, cable transmissions, microwave or optical fiber and received by receivers as recited in the claims respectively.

However, Hendricks discloses that it is known in the art to transmit video signals from a cable system (210) via telephone lines, cellular networks, fiber optics, personal communication networks and similar technology (interchangeably) to the home. See col. 7, lines 16-39. The transmission mediums used by cable stations are usually dependent on bandwidth availability and cost of the transmission medium or technique.

Art Unit: 2711

Therefore, it would have been obvious to one of ordinary skill in the art to modify Kostreski's system to include signals from the content provider to be transmitted via satellite, cable transmissions, microwave or optical fiber and received by receivers, as taught by Hendricks, because it is well known in the art that signals are transmitted via one or more transmission mediums or techniques (depending on bandwidth availability and cost) and received by receivers accordingly.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kostreski and applicant's admitted prior art.

Considering claim 6, Kostreski discloses all the claimed subject matter above in paragraph 2, except for the compression means is adapted to compress the digitized signals to a resolution of 256 by 240 pixels as recited in the claim.

However, applicant's conceded prior art at page 19, line 21 - page 20, line 5 discloses that "(VHS) video tapes or other publicly accepted medium have lower resolution than conventionally broadcast signals" and "the resolution of VHS-quality video is approximately 256 by 240 pixels".

Therefore, it would have been obvious to one of ordinary skill in the art to modify Kostreski's system (if necessary) to include the compression means to be adapted to compress the digitized signals to a resolution of 256 by 240 pixels because it is well known in the art that this is the minimum acceptable resolution for television images.

Art Unit: 2711

6. Claims 7-15 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kostreski and Hendricks.

Considering claim 7, Kostreski discloses a system for communicating with a plurality of subscribers. Note the following:

- a) the claimed plurality of receivers is met by plural encoders (11) (figure 6);
- b) the claimed processing means is met by encoders (11), see col. 9, lines 52 - 56;
- c) the claimed means for digitizing and compressing is met by encoders (11), see col. 9, lines 49 - 52;
- d) the claimed multiplexer is met by multiplexer (12) (figure 6);
- e) the claimed means for modulating is met by modulator (13); and
- f) the claimed RF upconverter means is met by upconverters (14) or (24) which upconverts in UHF spectrum, see col. 13, line 13 - col. 14, line 41;
- g) the claimed amplifier is met by amplifier (23);
- h) the claimed antenna is met by antenna (27) or (TXN); and
- i) the claimed aggregation of programming sources provided point to multipoint is met by the headend (10) (figure 6) providing plural video programs to multiple receivers (100) (figure 7).

Kostreski fails to specifically disclose ii) inserting desired information into the digitized programs and a return path subsystem including processing means for receiving communications from the subscriber as recited in the claim.

Art Unit: 2711

However, Hendricks discloses a bi-directional CATV system comprising a program subsystem (260), transmission subsystem (209) and a return path subsystem (214) (figure 7). The return path subsystem (214) (figures 7, 9A, 9B, 11) comprises a processor (224) for processing communications from the subscriber (i.e. program requests). This facilitates desired programs and other information to be inserted into the digitized programs and transmitted to subscribers. See col. 26, line 12 - col. 32, line 39. This return path subsystem when utilizing existing PSTN (Public Switched Telephone Network) is the most basic method of receiving messages from subscribers.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Kostreski's system to include inserting desired information into the digitized programs and a return path subsystem including processing means for receiving communications from the subscriber, as taught by Hendricks, for the advantage of receiving and processing subscribers' requests in order to transmit desired programming to the subscribers.

Considering claim 8, Kostreski discloses a system for communicating with a plurality of subscribers. Note the following:

- a) the claimed plurality of receivers is met by plural encoders (11) (figure 6);
- b) the claimed processing means is met by encoders (11), see col. 9, lines 52 - 56;
- c) the claimed means for digitizing and compressing is met by encoders (11), see col. 9, lines 49 - 52;

Art Unit: 2711

- d) the claimed multiplexer is met by multiplexer (12) (figure 6);
- e) the claimed means for modulating is met by modulator (13); and
- f) the claimed RF upconverter means is met by upconverters (14) or (24) which upconverts in UHF spectrum, see col. 13, line 13 - col. 14, line 41;
- g) the claimed amplifier is met by amplifier (23);
- h) the claimed antenna is met by antenna (27) or (TXN); and
- i) the claimed aggregation of programming sources provided point to multipoint is met by the headend (10) (figure 6) providing plural video programs to multiple receivers (100) (figure 7).

Kostreski fails to specifically disclose a return path subsystem including processing means for receiving communications from the subscriber as recited in the claim.

However, Hendricks discloses a bi-directional CATV system comprising a program subsystem (260), transmission subsystem (209) and a return path subsystem (214) (figure 7). The return path subsystem (214) (figures 7, 9A, 9B, 11) comprises a processor (224) for processing communications from the subscriber (i.e. program requests). This communications include program modification, authorization, billing information, subscriber programming preferences. See col. 26, line 12 - col. 32, line 39. This return path subsystem when utilizing existing PSTN (Public Switched Telephone Network) is the most basic method of receiving messages from subscribers.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Kostreski's system to include a return path subsystem including processing means for receiving

Art Unit: 2711

communications from the subscriber, as taught by Hendricks, for the advantage of receiving, processing and maintaining all relevant information pertaining to subscribers (i.e. program requests, billing information, personal viewing choices etc.)

Claim 9 is met by the combined systems of Kostreski and Hendricks, since the purpose of the return path subsystem is to affect (i.e. modify) program selection (at the program subsystem) for transmission to subscribers as discussed throughout the Hendricks reference including but not limited to col. 26, line 12 - col. 27, line 49.

Claim 10 is met by the combined systems of Kostreski and Hendricks, since the network controller (214) (the program subsystem) disclosed by Hendricks sends authorization codes to the subscribers as discussed throughout the Hendricks reference including but not limited to col. 27, lines 34-49 and col. 33, lines 5-38.

Claim 11 is met by the combined systems of Kostreski and Hendricks, since the computer system (244) (figure 7) of Hendricks is essentially a video server system working in association with cpu (224) for selecting/transmitting programs and authorization codes to subscribers. See col. 23, lines 43, col. 27, lines 34-49 and col. 33, lines 5-38.

Art Unit: 2711

Claim 12 is met by the combined systems of Kostreski and Hendricks, since data storage means are essential for processing subscriber requests and other information as illustrated by Hendricks at (226) (figure 7) or (226) (figure 11).

Claim 13 is met by the combined systems of Kostreski and Hendricks, wherein the account/billing information is stored in database (316) (figure 11) illustrated by Hendricks.

Claim 14 is met by the combined systems of Kostreski and Hendricks, wherein the subscriber preference information is met viewer profile database (314)(figure 11) illustrated by Hendricks and disclosed in col. 29, line 60 - col. 30, line 49 and throughout the Hendricks reference.

Considering claim 15, Kostreski discloses a system for communicating with a plurality of subscribers. Note the following:

- a) the claimed plurality of receivers is met by plural encoders (11) (figure 6);
- b) the claimed processing means is met by encoders (11), see col. 9, lines 52 - 56;
- c) the claimed means for digitizing and compressing is met by encoders (11), see col. 9, lines 49 - 52;
- d) the claimed multiplexer is met by multiplexer (12) (figure 6);
- e) the claimed means for modulating is met by modulator (13); and

Art Unit: 2711

- f) the claimed RF upconverter means is met by upconverters (14) or (24) which upconverts in UHF spectrum, see col. 13, line 13 - col. 14, line 41;
- g) the claimed amplifier is met by amplifier (23);
- h) the claimed antenna is met by antenna (27) or (TXN);
- i) the claimed plural intelligent control boxes are met by intelligent terminals (100) (figures 7-9);
- j) the claimed tuner, input device and processor are met by tuner (201) figure 9, ir receiver (145) (figure 8) and processor(s) (125 or 110) (figure 8); and
- k) the claimed aggregation of programming sources provided point to multipoint is met by the headend (10) (figure 6) providing plural video programs to multiple receivers (100) (figure 7).

Kostreski fails to specifically disclose a return path subsystem including processing means for receiving communications from the subscriber as recited in the claim.

However, Hendricks discloses a bi-directional CATV system comprising a program subsystem (260), transmission subsystem (209) and a return path subsystem (214) (figure 7). The return path subsystem (214) (figures 7, 9A, 9B, 11) comprises a processor (224) for processing communications from the subscriber (i.e. program requests). This communications include program modification, authorization, billing information, subscriber programming preferences. See col. 26, line 12 - col. 32, line 39. This return path subsystem when utilizing existing PSTN (Public Switched Telephone Network) is the most basic method of receiving messages from subscribers.

Art Unit: 2711

Therefore, it would have been obvious to one of ordinary skill in the art to modify Kostreski's system to include a return path subsystem including processing means for receiving communications from the subscriber, as taught by Hendricks, for the advantage of receiving, processing and maintaining all relevant information pertaining to subscribers (i.e. program requests, billing information, personal viewing choices etc.)

The limitations set forth in claims 32-34 have been discussed above regarding corresponding claims 8, 9 and 12 respectively. Note that claims 32-34 correspond to claims 8, 9 and 12 respectively, except that "UHF" is recited in claim 8 and not in corresponding claim 32.

#### *Allowable Subject Matter*

Claims 35-47 are allowable because the prior art fails to disclose or suggest a device for permitting a subscriber to interact with an asymmetrical data communications system comprising the combination and arrangement of an input selector, a digital tuner for receiving digital UHF transmissions, an analog tuner, decoder, signal generation means, processor and network interface or a method of providing asymmetric data communication services comprising the combined steps of receiving, digitizing, multiplexing, modulating, channelizing, transmitting, receiving the PSTN message from a subscriber and retransmitting to other service providers as recited in the claims.

Art Unit: 2711

***Response to Arguments***

7. The declaration filed on 6/28/99 under 37 CFR 1.131 has been considered but is ineffective to overcome the Kostreski (5,563,892) reference.

The declaration is defective because it does not include the statement that the “facts showing a completion of the invention in this country or in a NAFTA or WTO member country before the filing date of the application on which the U.S. patent issued”. Note that applicant only mentions on page 1 of the declaration that “I worked on the subject matter of the above-identified application...on behalf of BellSouth Corporation (“BellSouth”)”.

The declaration is defective because applicant did not state at least one of the three ways in which an applicant can establish prior invention of the claimed subject matter as required under 37 CFR 1.31(b). Applicant provided a statement on page 6 (last paragraph) of the amendment submitted 6/28/99, but it is not cited in the declaration itself.

8. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Kostreski reference.

The evidence submitted does not appear to be original sketches, blueprints, photographs, lab notebook entries or photocopies thereof. See MPEP 715.07 and 37 CFR 1.31 (b). Note that the exhibits (containing diagrams and photographs) indicate and illustrate testing and use of

Art Unit: 2711

equipments prior to March 16, 1995. However, the exhibits themselves do not appear to be the original or actual documents used in the testing and use of the equipments.

9. Applicant should note that the references listed on Information Disclosure Statement received 5/5/98 has not been received by the Office. The examiner contends that applicant should provide the references for consideration on the merits.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Conclusion*

11. **Any response to this final action should be mailed to:**

Art Unit: 2711

**Box AF**

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Washington, D.C. 20231**

**or faxed to:**

**(703) 308-9051, (for formal communications; please mark  
"EXPEDITED PROCEDURE")**

**Or:**

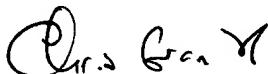
**(703) 308-5359 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")**

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Grant whose telephone number is (703) 305-4755. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 3900.



**Chris Grant  
Primary Examiner  
November 24, 1999**